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28 JUN 2000

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In re Application of  
Sarolf SAUER et al.  
Application No.: 09/446,128  
PCT No.: PCT/EP98/03349  
Int. Filing Date: 04 June 1998  
Priority Date: 04 July 1997  
Attorney's Docket No.: A-6865  
For: PROCESS FOR FURTHER PROCESSING OF  
SMALL GLASS PARTICLES

:  
: DECISION ON  
:  
: PETITION  
:  
: UNDER 37 CFR 1.47(a)  
:  
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This decision is in response to applicants' "Rule 47(b) Petition", filed 03 April 2000, to accept the application without the signature of co-inventor Sarolf Sauer. The petition is being treated as a petition under 37 CFR 1.47(a) because joint inventor Christian Klepsch has executed the application. A petition under 37 CFR 1.47(b) is appropriate only if all of the inventors refuse to execute the application.

BACKGROUND

On 04 June 1998, applicants filed international application PCT/EP98/03349, claiming priority to German application 197 28 682.8, filed 04 July 1997. A Demand for international preliminary examination, in which the United States was elected, was filed 04 January 1999. Accordingly, the thirty month period for paying the basic national fee in the United States in accordance with 37 CFR 1.495(b), expired at midnight on 04 January 2000.

On 28 December 1999, applicants filed a Transmittal Letter (PTO Form 1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required under 35 U.S.C. 371(c)(1).

On 03 March 2000, the United States Designated/Elected Office (PTO) mailed a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required. The Notification set a ONE (1) MONTH period for response.

On 04 April 2000, applicants filed a "Rule 47(b) Petition" which included the petition fee under 37 CFR 1.17(i), a declaration and power of attorney executed by Christian Klepsch, and a notarial deed (contract of employment).

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicants have satisfied items (1), (3), and (4) above.

Regarding item (2) above, MPEP 409.03(d) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The supporting documentation submitted with the petition included: 1) a statement by an attorney of record that Sarolf Sauer refuses to sign the application and 2) a notarized deed selling the above captioned application to Glas-Constructions Gesellschaft m.b.H. Neither

document provides factual proof that Sarolf Sauer refuses to sign the application. The statement by attorney Stewart Gitler that Sauer refuses to sign the application does not provide any evidence that a bona fide attempt was made to present a copy of the application papers to Sauer. There is no evidence that a copy of the application papers were sent to Sauer's last known address. Moreover, Mr. Gitler's statement is not in the form of an affidavit or declaration nor does it indicate that Sauer's refusal was made in the presence of Mr. Gitler. Finally, the notarized deed is not evidence of Sauer's refusal to sign because it does not provide or support any facts regarding Sauer's refusal to sign the application.

### CONCLUSION

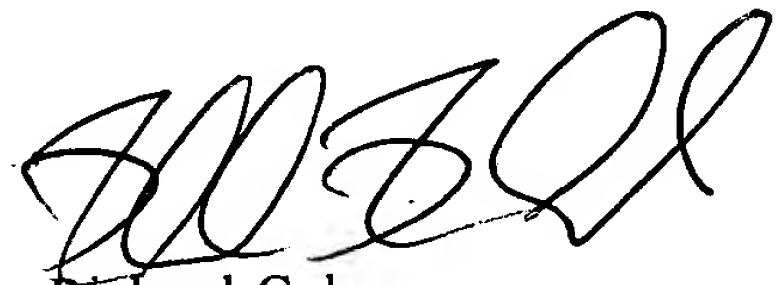
For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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